

Appl. No. : 10/768,717
Filed : January 30, 2004

REMARKS

Claims 1-17 are currently pending in the application. Claims 1 and 11 has been amended for clarification purposes as noted.

Rejections of Claims 1-10 under 35 U.S.C. § 102(e)

Claims 1-10 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,447,530 to Ostrovsky et al. ("Ostrovsky"). Claims 1-8 and 10 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,371,971 to Tsugita et al. ("Tsugita '971").

Claim 1 has been amended for clarification to recite, inter alia, "an adjustable device deployment system, for implanting an implantable device within an opening in the body comprising: an implantable device, said device being movable between a reduced cross section and an enlarged cross section, said device having a proximal end and a distal end, and wherein said device, when fully expanded, increases radially in dimension from its proximal end to an apex portion, and then decreases radially in dimension from the apex portion to the distal end. . ."

Applicants note that proper written description support for this amendment can be found, for example, in Fig. 33, and paragraph [0110] of the disclosure. As described in the specification, in one embodiment, proximal retraction on the deployment line 240 will cause the distal hub 191 to be drawn toward the proximal hub 222, thereby radially enlarging the cross-sectional area of the occlusion device 10 (paragraph [0110]). As shown in Fig. 33, the device increases radially in dimension from its proximal end to an apex portion, and then decreases radially in dimension from the apex portion to the distal end portion when the device is fully expanded, that is, after the two hubs 191, 222 are drawn together using the loop 244.

Ostrovsky

Although Applicants do not agree with the rejections, Claim 1 has been amended herein for clarification purposes, and the amendment is fully supported, as noted above. Applicants respectfully submit that Ostrovsky fails to identically teach every element of Claim 1, as amended herein. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must identically teach every element of the claim).

Appl. No. : 10/768,717
Filed : January 30, 2004

The Examiner found that Ostrovsky teaches an implantable device that, as shown in Fig. 32, "is capable of attaining a configuration having a small diameter at its two ends 204, 212 and rises to a central apex therebetween" (Office Action, p. 2). Applicants note that Fig. 32 does not illustrate the device's implanted, fully expanded configuration; the configuration noted by the Examiner between the struts 202 and retraction members 208 exists only as a transitional configuration when the device is being removed, when the tether pulls on retraction members 208. When fully expanded and deployed within a blood vessel, Applicants note Ostrovsky's device has criss-crossing struts 202, retraction members 208, and loops 210 as shown in Fig. 29, contrary to the shape recited in amended Claim 1. Therefore, inter alia, because of the distinct shape characteristics of the device recited when fully expanded, amended Claim 1 is not anticipated by Ostrovsky. We thus request that the Examiner withdraw this rejection. Applicants note that Claims 2-10 depend from Claim 1 and contain all of the limitations thereof in addition to further distinguishing features; thus Applicants submit that these claims are in condition for allowance as well.

Tsugita '971

Applicants respectfully submit that Tsugita '971 is not a 35 U.S.C. § 102(e) reference to the present application. § 102(e)(2) states, in relevant part: A person shall be entitled to a patent unless the invention was described in "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . ." [emphasis added].

Applicants note that the application maturing into Tsugita '971 was filed on April 28, 2000, patented on April 16, 2002, and claims priority as a continuation to Application No. 09/440,204 filed November 15, 1999. The present application was filed January 30, 2004, and claims priority as a continuation to Application No. 09/435,562, filed on November 8, 1999, predating Tsugita '971's earliest priority date. In light of the foregoing, Applicants request that this rejection be withdrawn.

Appl. No. : 10/768,717
Filed : January 30, 2004

Rejection of Claims 11-17 under 35 U.S.C. § 103(a)

The Examiner rejected Claims 11-17 under 35 U.S.C. § 103(a) as being unpatentable over Ostrovsky in view of Brooks et al (U.S. Patent No. 6,346,116 B1) ("Brooks") and Tsugita et al. (U.S. Patent No. 5,911,734) ("Tsugita '734").

Claim 11 has been amended for clarification to recite, *inter alia*, "an adjustable device deployment system, for implanting an implantable device within an atrial appendage comprising . . . a deployment line adapted to extend through the deployment catheter releasably attached to the implantable device, wherein the implantable device is moveable between its reduced and enlarged cross sections while the proximal end of the implantable device is distal to the distal end of the deployment catheter."

Applicants note that proper written description support for this amendment can be found, for example, in Fig. 33, and paragraph [0110] of the disclosure. In one embodiment, proximal retraction on the deployment line 240 will cause the distal hub 191 to be drawn toward the proximal hub 222, thereby radially enlarging the cross-sectional area of the occlusion device 10. (paragraph [0110]). As clearly illustrated in Fig. 33, when the two hubs 191, 222 are drawn together using the loop 244, the device is movable between a reduced cross section and an enlarged cross section while the proximal end of the device is distal to deployment catheter 238.

The Examiner found that Ostrovsky discloses the invention as claimed with the exception of the material of the filter having a membrane and the material of the membrane being ePTFE; Tsugita discloses a filter with a membrane; and that it would have been obvious to have placed a membrane on the filter of Ostrovsky. The Examiner further alleges that this provides an effective means to filter out undesirable particles while allowing blood-flow therethrough, and placing the membrane on the proximal face of the filter as taught by Tsugita will allow the interior of the mesh to be directed upstream to collect debris if introduced in a retrograde orientation. Furthermore, Examiner states it would have been obvious, as in Claim 15, to use ePTFE as the filter material as disclosed in Brooks.

Although Applicants do not agree with the rejections, Claim 11 has been amended herein for clarification purposes, and the amendment is fully supported, as noted above. Applicants request that the obviousness rejection be withdrawn because none of the cited references teaches or suggests all of the recited claim limitations of Claim 11, as amended. Furthermore, Applicants

Appl. No. : 10/768,717
Filed : January 30, 2004

submit that one of ordinary skill of the art would have no motivation to produce the claimed features of the present application from either reference cited. See M.P.E.P. § 2143.

Ostrovsky discloses that the steps of the removal process in reverse would provide a method of placing a filter 200 in a vessel, as shown in Figs. 29-35 (col. 10, ll. 49-56). Ostrovsky's device is movable from a reduced to an enlarged cross section; however, the full range of the expansion process occurs when at least part of the device, such as hub 212 and tether connector 214, is still within the deployment catheter, as shown in Fig. 33. The device already assumes an enlarged cross section when first distal to the deployment catheter, and therefore cannot move from a reduced to an enlarged cross section while its proximal end is distal to the deployment catheter. Therefore, the references cited, even when combined, do not teach or suggest all of the limitations of amended Claim 11.

In light of the above, Applicants assert that Claim 11 is not obvious in view of the prior art references, and respectfully request that the Examiner withdraw this rejection. Applicants also note that Claims 12-17 depend from Claim 11 and contain all of the limitations thereof in addition to further distinguishing features; thus Applicants submit that they are in condition for allowance as well.

Appl. No. : **10/768,717**
Filed : **January 30, 2004**

CONCLUSION

For the reasons presented above, Applicants submit that the present application is in condition for allowance and respectfully request the same. If any issues remain, the Examiner is cordially invited to contact Applicants' representative at the number provided below in order to resolve such issues promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/15/05

By:



Sabing H. Lee
Registration No. 43,745
Attorney of Record
Customer No. 20,995
(949) 760-0404

2664834
060706